

REMARKS/ARGUMENTS

Reconsideration and allowance of the present application based on the above amendments and the following remarks are respectfully requested.

Upon entry of the above amendments, claims 1-3, 5-9, and 11-23, as amended, will be pending of which claims 1, 14, and 20 are independent. Claim 1 has been amended to include the features of claims 4 and 10, which have consequently been cancelled. Furthermore, claim 14 has been revised to include that at least 50wt% of the monofunctional reactive diluents in the composition is absent an aromatic ring (if monofunctional diluent is present). Finally, new claims 20-23 have been added. No new matter has been introduced.

Claims 1-3, 7, 12, and 19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Chawla '202 (U.S. 5,977,202). Also, claims 1, 4, 7, 11-13, and 19 stand rejected as being anticipated by Ishikawa (WO 99/52958). Furthermore, claims 1-2, 4, 7, 12-13, and 19 stand rejected as being anticipated by Snowwhite (U.S. 6,323,255). In addition, claims 4-6, 9, 11, and 18 stand rejected as being anticipated by or, in the alternative, as being obvious over Chawla '023. Applicants respectfully traverse these rejections for at least the following reasons.

Applicants note that the present application contains three independent claims, *i.e.* claims 1, 14, and 20 (with claim 20 being newly added). The above rejections do not include rejections of claims 14 and 20. Furthermore, Applicants note that claim 10 has now been included in claim 1 and that the above rejections do not include a rejection of claim 10. Accordingly, it is respectfully submitted that the above rejections are moot.

Claims 1-4, 7-13, and 19 stand rejected as being anticipated by Chawla '023 (U.S. 5,907,023). Applicants respectfully traverse these rejections for at least the following reasons.

First, the rejections do not include rejections for independent claims 14 and 20. Regarding claim 1, Applicants note that instant claim 1 features that the composition comprises at least

one radiation-curable oligomer, wherein said oligomer includes diisocyanate residues and wherein **at least 50 mole % of the diisocyanates used to form the oligomer is absent a cyclic structure**. For the rejection of claims 1-4, 7-13, and 19 over Chawla '023, the Examiner relies on an embodiment wherein "the composition can comprise a urethane acrylate oligomer" ... "[s]aid urethane acrylate is prepared by the reaction of an oligomer polyol, **an aromatic diisocyanate**, and hydroxy functional ethylenically unsaturated monomer". See paragraph 3 of the outstanding Office Action (emphasis added).

Accordingly, it is respectfully submitted that the rejection of claim 1, which features that at least 50 mole % of the diisocyanates used to form the oligomer is absent a cyclic structure, should be withdrawn.

Finally, claims 4-6, 9-11, and 14-18 stand rejected as anticipated by or, in the alternative, as obvious over Chawla '202. Applicants respectfully traverse these rejections for at least the following reasons.

Applicants note that the rejected claims, either directly or indirectly, relate back to independent claims 1 and 14. Claims 1 and 14 feature an oligomer that includes diisocyanate residues, wherein at least 50 mole % of the diisocyanates used to form the oligomer is absent a cyclic structure. In this regard, the Examiner acknowledges that "Chawla et al. does not expressly teach using an oligomer having diisocyanate moieties, wherein at least 50 mol% of said diisocyanate moieties lacks cyclic structures". See page 7 of the outstanding Office Action. Indeed, Applicants note that Chawla '202 prefers TDI and IPDA as diisocyanates. See column 5, lines 57-58 of Chawla '202.

Furthermore, the Examiner contends that it would be obvious to select a non-aromatic diisocyanate to avoid yellowing. See, generally, pages 7-8 of the outstanding Office Action, such as the Examiner's reference to column 5, lines 28-30, of Chawla '202. Assuming, *in arguendo*, that the Examiner is correct in that Chawla provides motivation to select non-aromatic diisocyanates, the Examiner still fails to point out why one would select a **non-cyclic** diisocyanate.

In addition, Applicants respectfully submit that Chawla '202 provides no guidance as to ensuring that at least 50 wt% of the monofunctional reactive diluents is non-aromatic. The Examiner's comments regarding cyclic structures and regularity patterns are noted (*See* page 8 of the Office Action), but Applicants kindly note that the Examiner has not pointed out where these assertions find support.

Accordingly withdrawal of all rejections over Chawla '202 is respectfully requested.

Therefore, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By: Richard A. Steinberg
Richard A. Steinberg
Registration No. 26,588
Direct No. (703) 905-2039

Paul L. Sharer
Registration No. 36,004
Direct No. (703) 905-2180

P.O. Box 10500
McLean, VA 22101
(703) 905-2000 Telephone
(703) 905-2500 Facsimile

Date: October 20, 2003